

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 20, 2006.

By: Deleene C. Gaudin



Attorney Docket No. 84533-000000US PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of:

GREGORY E. RICE et al.

Application No.: 10/525,596

Filed: February 23, 2005

For: DEPLETION OF PLASMA  
PROTEINS

Confirmation No. 5867

Examiner: Unassigned

Art Unit: Unassigned

**PETITION UNDER  
37 CFR 1.47(a)**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**RECEIVED**

30 JUN 2006

Legal Staff  
International Division

In response to the Notification of Missing Requirements under 35 USC 371, mailed on September 20, 2005, Applicants submit herewith a Declaration in support of the Petition, executed by Elizabeth Kennedy, Corporate Counsel for the Assignee, Royal Women's Hospital, and the instant Petition following inventor Mark Baker's refusal to join in the subject application.

In accordance with 37 CFR 1.47(a), Applicants set forth the following:

05/01/2006 GFREY1 00000123 201430 10525596  
02 FC:1463 200.00 DA

**PROOF OF THE PERTINENT FACTS**

Inventors Gregory E. Rice, Mark S. Baker and Michael Quinn are joint inventors of the invention claimed in the subject application. Mark S. Baker was employed by the Royal

Women's Hospital at the time the invention was made and the application for a patent on the same was filed.

Royal Women's Hospital, acting through its corporate counsel, has made numerous and reasonable requests for Mr. Baker's signature in connection with the filing of this application. The following outlines the correspondence between Royal Women's Hospital and Professor Baker, as supported in the accompanying declaration of Elizabeth Kennedy:

1. Letter to Professor Mark Baker dated 18 March 2005 (designated Exhibit EK1) from Royal Women's Hospital, Corporate Counsel, Elizabeth Kennedy, forwarding the declaration and assignment for signature to the U.S. national phase case (PCT/AU2003/001075, now USSN 10/525,596).

2. Letter to Elizabeth Kennedy, Corporate Counsel at Royal Women's Hospital dated 18 April 2005 (Exhibit EK3) from Professor Mark Baker requesting clarification of the formal papers regarding the U.S. national phase filing of PCT/AU2003/001075 and future royalties.

3. Memorandum from Elizabeth Kennedy, Corporate Counsel at Royal Women's Hospital dated 28 April 2005 (Exhibit EK4) to Professor Greg Rice and Professor Michael Quinn forwarding Mark Baker's 18 April 2005 letter and requesting their comments.

4. Letter to Elizabeth Kennedy, Corporate Counsel at Royal Women's Hospital dated 3 May 2005 (Exhibit EK5) from Professor Greg Rice

5. Letter telefaxed to Professor Baker dated 11 May 2005 (Exhibit EK6) acknowledging his request for information in his letter dated 18 April 2005 (Exhibits EK3), explaining the position of Royal Women's Hospital (Exhibits EK4, EK5), and requesting again that the formal documents be signed.

6. Follow-up letter to Professor Baker dated 20 March 2006 (Exhibit EK2) from Elizabeth Kennedy of the Royal Women's Hospital, forwarding a copy of the PCT publication and declaration and assignment forms again requesting Baker's signature.

As indicated in the declaration of Ms. Kennedy, as of April 3, 2006, she has heard nothing further from Mark Baker, nor has the undersigned been advised of any contact as of the filing date of this paper, and thus it may be concluded that joint inventor Mark Baker remains uncooperative and refuses to execute the inventors' declaration.

LAST KNOWN ADDRESS OF THE NON-SIGNING INVENTOR

Applicants submit that the last known address of the non-signing inventor as:  
Mark S. Baker, 33 Chianti Court, Glenwood, New South Wales, 2768 Australia.

FEE SET FORTH IN § 1.17(h)

The Commissioner is hereby authorized to deduct the appropriate fee of \$200 from the undersigned's Deposit Account No. 20-1430 for consideration of this Petition. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

CONCLUSION

Applicants respectfully petition to proceed with the subject application on behalf of joint inventors Gregory E. Rice and Michael Quinn and without the signature of non-signing joint inventor Mark Baker as provided by 37 CFR 1.47(a). If the Examiner believes a telephone

conference would expedite prosecution of this application, please telephone the undersigned at  
(206) 467-9600.

Respectfully submitted,

Dated: April 20, 2006

By: Steven W. Parmelee  
Steven W. Parmelee  
Reg. No. 31,990

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, California 94111  
Telephone: (206) 467-9600  
Telefax: (206) 623-6793  
SWP/acg  
encs.

Commonwealth of Australia

*Statutory Declarations Act 1959*

AUSTRALIA

IN THE MATTER OF  
US Patent Application  
Derived from PCT application No.  
PCT/AU2003/001075  
in the name of Rice, Quinn and Baker  
and –  
IN THE MATTER OF  
Failure of Baker to execute Declaration and  
Assignment documents



**STATUTORY DECLARATION**

I, Elizabeth Kennedy, of Level 1 132 Grattan Street Carlton in the State of Victoria  
Australia, Lawyer

make the following declaration under the *Statutory Declarations Act 1959*:

1. I am Corporate Counsel of Royal Women's Hospital, of 132 Grattan Street, Carlton, Victoria, Australia, 3053 (RWH). I am responsible for coordinating the documentation required for patent protection for RWH inventions.
2. By letter dated 18 March 2005 (attached as exhibit EK1, with enclosures) I wrote to Professor Mark Baker (referred to hereinafter as Baker) and informed him that the PCT application on which he was named as an inventor, PCT/AU2003/001075, had entered the national phase in the United States. I asked him to sign the Declaration and Assignment documents that were enclosed and return the executed documents to me. Baker was sent a copy of PCT/AU2003/001075 with my letter of 20 March 2006 (attached as exhibit EK2).
3. Baker replied to me on 18 April 2005 by letter dated 18 April 2005 (attached as exhibit EK3). He acknowledged receipt of my correspondence and sought further information before he would sign the documents.
4. In order to provide Baker with the information he sought, on 28 <sup>April</sup> March 2005 I sent an internal memorandum (attached as exhibit EK4) to Associate Professor Greg Rice (hereinafter referred to as Rice). Rice replied by letter dated 3 May 2005 (attached as exhibit EK5).
5. The information in the Rice letter of 3 May 2005 confirmed my initial understanding that rights in the invention described in PCT/AU2003/001075 belonged to RWH by

A handwritten signature in black ink, appearing to be "Rice".

virtue of its employment of Baker. On 11 May 2005 I wrote a letter to Baker outlining RWH's position and again asking for the forms to be signed and returned to me. My letter to Baker of 11 May 2005 was sent by facsimile transmission to the number provided in Baker's letter of 18 April 2005. A copy of the letter of 11 May 2005 and the fax transmission confirmation are attached as exhibit EK6.

6. I have received no further correspondence from Baker.

I understand that a person who intentionally makes a false statement in a statutory declaration is guilty of an offence under section 11 of the *Statutory Declarations Act 1959*, and I believe that the statements in this declaration are true in every particular.

Declared at Brighton  
on 3 April 2006

)  
)  
)

Rowan Kennedy

Before me:



Signature of Witness  
Rowan Kennedy

Level 50, 600 Bourke Street, Melbourne, Vic. 3000  
An Australian Legal Practitioner within the meaning  
of the Legal Profession Act 2004.

Name and Capacity of Witness

Note 1 A person who intentionally makes a false statement in a statutory declaration is guilty of an offence, the punishment for which is imprisonment for a term of 4 years – see section 11 of the *Statutory Declarations Act 1959*.

Note 2 Chapter 2 of the *Criminal Code* applies to all offences against the *Statutory Declarations Act 1959* – see section 5A of the *Statutory Declarations Act 1959*.

IN THE MATTER OF  
US Patent Application  
Derived from PCT application No.  
PCT/AU2003/001075  
in the name of Rice, Quinn and Baker  
and –  
IN THE MATTER OF  
Failure of Baker to execute Declaration and  
Assignment documents

**EXHIBIT EK3**

This is Exhibit EK3 referred to in of the Statutory Declaration of Elizabeth Kennedy dated  
this 3 day of April 2006.

Before me:

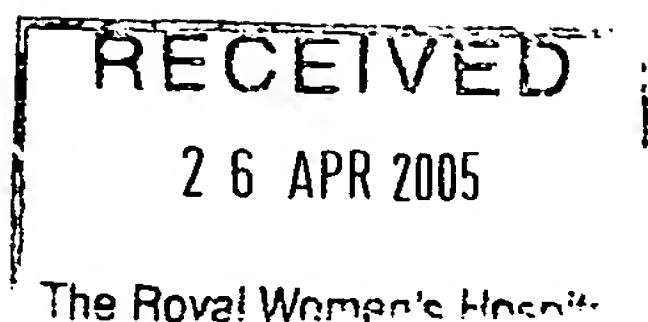


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Signature of Witness

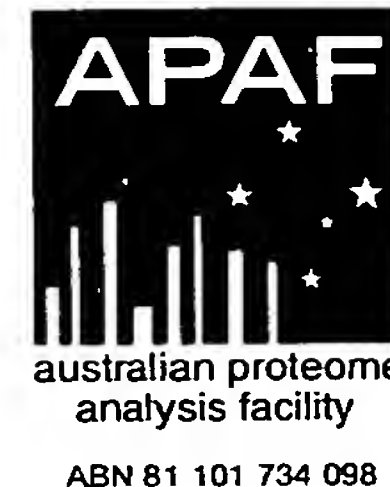
Rowan Kennedy  
Level 50, 600 Bourke Street, Melbourne, Vic. 3000  
An Australian Legal Practitioner within the meaning  
of the Legal Profession Act 2004.

\_\_\_\_\_  
Name and Capacity of Witness





EX 3



18 April 2005

Ms Elizabeth Kennedy  
Corporate Counsel  
Royal Women's Hospital  
132 Grattan Street  
Carlton VIC 3052

Dear Ms Kennedy

Thank you for your correspondence of 18 March 2005 regarding the United States of America Patent Application No PCT/AU2003/001075 in the name of RWH entitled "Depletion of Plasma Protein."

I have sought advice and considered the requests you have made in your correspondence and am willing to comply if you are able to provide me with information that I require in order to execute this process.

Firstly, in the document statement under 37cfr 3.73b, RWH has not indicated the type of assignee that it is. Could this please be provided and forwarded to me – even if by fax?

Secondly, in good faith, it is my understanding that you are simply asking me to sign an authority to allow the above PCT Patent to be filed in the USA and nothing else. It is my express understanding that this involves no transfer of my rights as the inventor of this technology to any other person or corporation whatsoever. It is also my understanding that there has not been any request for any licence to be granted to any third party since this patent application was filed. Please advise if this is not the case and if not please provide me with the precise financial details regarding any licence or subsequent assignment of rights to this technology that have been negotiated through the auspices of RWH.

Thirdly, for information please note that there has always been considerable discussion as to whether the work disclosed in PCT/AU2003/001075 was primarily conducted outside of the RWH work environment – eg not carried out during RWH working hours and not covered by any grants funded by that Institution. I trust that RWH recognises this fact and the implications emanating from this.

Australian Proteome Analysis Facility Ltd  
Level 4, Building F7B, Macquarie University, Sydney, NSW, 2109, Australia  
Ph: +61 2 9850 6201 • Fax: +61 2 9850 6200  
www.proteome.org.au • apafinfo@proteome.org.au

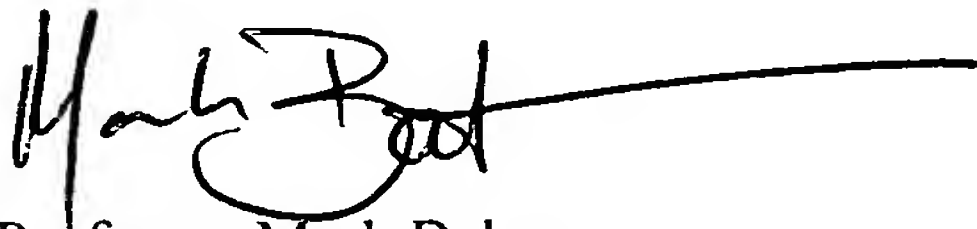
AUSTRALIAN PROTEOME ANALYSIS FACILITY LTD



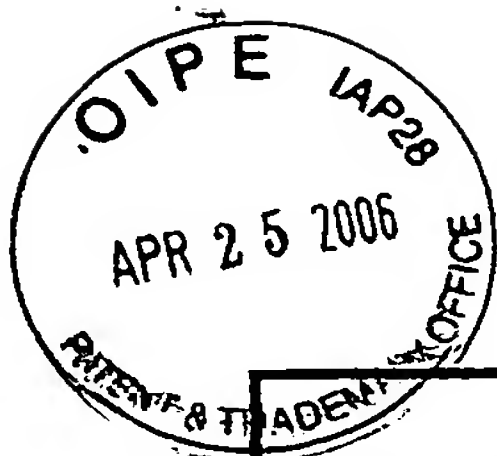
Finally, whilst I was employed at RWH I was not provided at any time with a copy of any Intellectual Property Policy that pertained to how intellectual property disclosed by inventors whilst employed at RWH would be secured, protected and managed nor how royalties would be distributed. I would appreciate you providing me with a copy of the relevant Intellectual Property policies that pertain in this case whether these have been written subsequent to the disclosure or not. Please include a description of how RWH proposes to deal with royalties and future licence agreements pertaining to this invention.

I look forward to hearing from you and executing this matter in a timely manner.

Yours sincerely

A handwritten signature in black ink, appearing to read 'Mark Baker', with a long horizontal line extending to the right.

Professor Mark Baker

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: GREGORY E. RICE, MARK BAKER, MICHAEL QUINNApplication No./Patent No.: \_\_\_\_\_ Filed/Issue Date: February 23, 2005Entitled: DEPLETION OF PLASMA PROTEINSROYAL WOMEN'S HOSPITAL, a \_\_\_\_\_

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or
2. ☐ an assignee of less than the entire right, title and interest.  
The extent (by, percentage) of its ownership interest is \_\_\_\_\_%

In the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_

The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.8]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

\_\_\_\_\_  
Date\_\_\_\_\_  
Telephone numberGregory E. Rice

Typed or printed name

  
SignatureScientific Director

Title

Attorney Docket No.: 084533-000000US  
Client Reference No.: AJS:AJH:RMB:FP21167

JOINT

### ASSIGNMENT OF PATENT APPLICATION

WHEREAS, GREGORY E. RICE of 23 Braden Brae Drive, Warranwood, Victoria 3134 Australia; MARK BAKER of 33 Chianti Court, Glenwood, New South Wales, 2768 Australia; MICHAEL QUINN of 4/28 Groom Street, Clifton Hill, Victoria 3068 Australia, hereinafter referred to as "Assignors," are the inventors of the invention described and set forth in the below-identified application for United States Letters Patent:

Title of Invention: DEPLETION OF PLASMA PROTEINS  
Dates of Execution: 3-10-06 and 3-14-06  
Filing Date: February 23, 2005  
Application No.: 10/525,596 ; and

WHEREAS, ROYAL WOMEN'S HOSPITAL of 132 Grattan Street, Carlton, Victoria, 3053, Australia, hereinafter referred to as "ASSIGNEE," is desirous of acquiring ASSIGNORS' interest in the said invention and application and in any U.S. Letters Patent which may be granted on the same;

NOW, THEREFORE, TO ALL WHOM IT MAY CONCERN: Be it known that, for good and valuable consideration, receipt of which is hereby acknowledged by Assignors, Assignors have sold, assigned and transferred, and by these presents do sell, assign and transfer unto the said Assignees, and Assignees' successors and assigns, all their right, title and interest in and to the said invention and application, and in and to any Letters Patent which may hereafter be granted on the same in the United States, the said interest to be held and enjoyed by said Assignees as fully and exclusively as it would have been held and enjoyed by said Assignors had this Assignment and transfer not been made, to the full end and term of any Letters Patent which may be granted thereon, or of any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof.

Assignors further agree that they will, without charge to Assignee, but at Assignee's expense, cooperate with Assignee in the prosecution of said application and/or applications, execute, verify, acknowledge and deliver all such further papers, including applications for Letters Patent and for the reissue thereof, and instruments of assignment and transfer thereof, and will perform such other acts as Assignee lawfully may request, to obtain or maintain Letters Patent for said invention and improvement, and to vest title thereto in Assignee, or Assignee's successors and assigns.

Assignors hereby authorize and request Townsend and Townsend and Crew LLP, Two Embarcadero Center, Eighth Floor, San Francisco, CA 94111-3834, to insert herein above the application number and filing date of said application when known.

IN TESTIMONY WHEREOF, Assignors have signed their names on the dates indicated.

Dated: 10-11-2006

  
Gregory E. Rice

**SIGNATURE WITNESSED BY:**

Dated: \_\_\_\_\_

\_\_\_\_\_  
Signature of Witness

\_\_\_\_\_  
Printed Name

Dated: \_\_\_\_\_

\_\_\_\_\_  
Signature of Witness

\_\_\_\_\_  
Printed Name

Dated: \_\_\_\_\_

\_\_\_\_\_  
Mark Baker

**SIGNATURE WITNESSED BY:**

Dated: \_\_\_\_\_

\_\_\_\_\_  
Signature of Witness

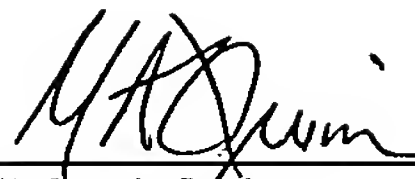
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\_\_\_\_\_  
Signature of Witness

\_\_\_\_\_  
Printed Name

Dated: 14/3/06

  
Michael Quinn

**SIGNATURE WITNESSED BY:**

Dated: \_\_\_\_\_

\_\_\_\_\_  
Signature of Witness

\_\_\_\_\_  
Printed Name

Dated: \_\_\_\_\_

\_\_\_\_\_  
Signature of Witness

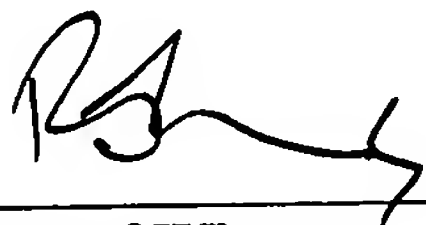
\_\_\_\_\_  
Printed Name

IN THE MATTER OF  
US Patent Application  
Derived from PCT application No.  
PCT/AU2003/001075  
in the name of Rice, Quinn and Baker -  
and -  
IN THE MATTER OF  
Failure of Baker to execute Declaration and  
Assignment documents

**EXHIBIT EK15**

This is Exhibit EK15 referred to in of the Statutory Declaration of Elizabeth Kennedy dated  
this 3 day of April 2006.

Before me:



\_\_\_\_\_  
Signature of Witness

**Rowan Kennedy**  
**Level 50, 600 Bourke Street, Melbourne, Vic. 3000**  
**An Australian Legal Practitioner within the meaning**  
**of the Legal Profession Act 2004.**

\_\_\_\_\_  
Name and Capacity of Witness

'EALS'



**Gynaecological Cancer  
Research Centre**

3 May 2005

Ms Elizabeth Kennedy  
Corporate Counsel  
The Royal Women's Hospital  
132 Grattan Street  
CARLTON VIC 3053

**Michael A Quinn**  
MB, ChB, MOG (Melb),  
MRCP (UK), MRCOG,  
FRACOG, COG  
Clinical Director

**Gregory E Rice**  
BSc (Hon), PhD,  
Grad Dip Mgt, MHA  
Scientific Director

Dear Elizabeth,

in response to your internal memorandum dated 28 April 2005, regarding United States of America Patent Application PCT/AU2003 001075, please find my comments below.

- (1) Paragraph 3 - I have sought clarification regarding the "type of assignee" from Griffith Hack.
- (2) Paragraph 4 -
  - a. Baker's rights as an inventor are not affected and remain the same as the other inventors (Quinn and Rice) involved in this patent. ie, entitled to an equal share of one-third of any royalty stream returned to The RWH that should result from this patent.
  - b. Rights of the inventor are distinct from the issue of who owns the intellectual property. As Quinn and Rice were not solely RWH employees, both have assigned intellectual property to The RWH, Baker as an employee of The RWH owns none of the intellectual property generated by the GCRC as, in the absence of an agreed IP Policy, ownership reverts to the employer, ie The RWH.
- (3) Paragraph 5 – the outside work Baker refers to relates to the production of chicken antibodies at 23 Braden Brae Drive, Warranwood. This aspect of the project:
  - i. represents <10% of total research effort involved in this project;
  - ii. was conducted under the auspices of The RWH Research and Ethics Committee and as an RWH research project;
  - iii. was solely conducted by GE Rice (Baker had absolutely no contribution to this aspect of the project); and
  - iv. was funded solely by GE Rice.

The majority of the project (ie 90%) was conducted within the GCRC within working hours by GCRC-funded technicians.

- (4) Paragraph 6 – This is correct – no intellectual property policy had been developed or provided by The RWH during Baker's tenure.

I hope you find these comments helpful

Yours sincerely

**A/Prof Greg Rice**  
Scientific Director

GER:jah



IN THE MATTER OF  
US Patent Application  
Derived from PCT application No.  
PCT/AU2003/001075  
in the name of Rice, Quinn and Baker  
and –  
IN THE MATTER OF  
Failure of Baker to execute Declaration and  
Assignment documents

**EXHIBIT EK6**

This is Exhibit EK6 referred to in of the Statutory Declaration of Elizabeth Kennedy dated  
this 3 day of April 2006.

Before me:



Signature of Witness

Rowan Kennedy  
Level 50, 600 Bourke Street, Melbourne, Vic. 3000  
An Australian Legal Practitioner within the meaning  
of the Legal Profession Act 2004.

Name and Capacity of Witness

'BAC 6'



**The Royal Women's Hospital, Melbourne**

ABN 62 787 822 077

132 Grattan Street  
Carlton, Victoria, Australia, 3053

Telephone (03) 9344 2000

ISD (+613) 9344 2000

Facsimile (03) 9348 1840

**FAXED**  
11 5 05

11 May 2005

Professor Mark Baker  
Level 4 Building F&B  
Macquarie University  
SYDNEY NSW 2000

cc'd to G Rice  
m Quinn  
A Hui

**By Facsimile: (02) 9850 6200**

Dear Professor Baker

I acknowledge receipt of your letters dated 18 April and 21 April 2005.

In relation to your queries concerning the American Patent Application No. PCT/AU2003/001075 I advise that The Royal Women's Hospital (RWH) is the owner of all intellectual property in the patent by virtue of a Deed of Assignment executed between the University of Melbourne and Women's & Children's Health.

The RWH does not regard you as having any rights as the "inventor" because, as I stated to you in my letter of 18 March 2005, it regards your having worked on the subject matter of the patent whilst an employee of the RWH. I confirm that you were asked to sign the authority so as to allow the PCT Patent to be filed in the USA.

To the best of my knowledge, there was no intellectual property policy at the time that you were employed at the RWH, and therefore the position at common law pertained, viz. your employer at the time owned all intellectual property generated by you during the course of your work at the Hospital.

It is my understanding that the other inventors named were at the relevant time employees of the University of Melbourne hence the need for an agreement between the University of Melbourne on behalf of those inventors and Women's & Children's Health to assign IP.

I trust that this answers your queries. Please let me have the relevant form signed and returned as soon as possible.

In relation to your request for a copy of the two research grants in which you were named as an applicant I have asked Mr Hui, Administrative Officer of the Research and Ethics Secretariat to forward a copy of these applications to you under separate cover.

Yours sincerely,

**Elizabeth Kennedy**  
Corporate Counsel

ROYAL  
CHILDREN'S  
HOSPITAL



**FAXED**



**ELIZABETH J KENNEDY**

**Corporate Counsel**

***The Royal Children's Hospital and The Royal Women's Hospital***

***Ph. 9344 3298 Fax 9349 2392***

***Email: elizabeth.kennedy@wch.org.au***

***FACSIMILE***

***TO: Professor Mark Baker***

***DATE: 11 May 2005***

***TEL: (02) 9850 6200***

***No. of Pages (incl cover sheet: 2***

***FAX:***

***SUBJECT: Patent Application No. PCT/AU2003/001075***

☐ **URGENT**

☐ **CONFIDENTIAL**

**Executive Office, Level 1, 132 Grattan Street, Carlton 3053**

***Confidential This document is confidential and subject to legal professional privilege. It has been produced solely for the purpose of giving legal advice and or use in legal proceedings.***

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